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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/671,119      | 09/24/2003  | Matthew B. Prince    | 006470.P001         | 7247             |

7590 02/01/2008  
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EXAMINER

ABEDIN, SHANTO

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2136

| MAIL DATE | DELIVERY MODE |
|-----------|---------------|
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02/01/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/671,119

Applicant(s)

PRINCE, MATTHEW B.

Examiner

Shanto M Z Abedin

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 23 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 29-36 and 67-82 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-36 and 67-82 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/ are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***DETAILED ACTION***

1. This is in response to the communication filed on 11/23/2007.
2. Claims 29-36 and 67-82 are pending in the application.
3. Claims 29-36 and 67-82 have been rejected.

***Response to Arguments***

4. The applicant's arguments regarding the previous 35 U.S.C. 103(a) type rejections of claims 29-36 and 67-82 are fully considered, however found not persuasive. In particular, in response to the applicant's argument that cited references fail to disclose applying a one-way hashing scheme to the set of one or more email list entries to convert the strings of characters into unique hashed values to create a set of one or more hashed email list entries, wherein the one way hashing scheme is intended to conceal the email list entries from an intended recipient, the examiner respectfully disagrees with the applicant since use of a do-not-contact or do-not-email list is taught by reference Ben Livingston, and use of hashing mechanism to conceal the email entry is taught by Morkel, therefore, the combination of the cited references does teach these limitations (please see below for detail). However, upon further consideration, a new ground of rejection is found, and the applicant's arguments are further moot in view of new grounds of rejection presented in this office action.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 29-36 and 67-82 are rejected under 35 USC 103 (a) as being unpatentable over Morkel (US 7007068 B2) in view of Ben Livingston (Possible modifications to Washington, anti-spam law, Internet Newsgroup, January 31, 2002) further in view of Russell (US 7099444B1).

*Regarding claim 29, Morkel discloses computer implemented method comprising:*

collecting a set of one or more email list entries, each email list entry is a string of characters representing an email address (Col 2, starts at line 20);

applying a one-way hashing scheme to the set of one or more email list entries to convert the strings of characters into unique hashed values to create a set of one or more hashed email list entries, wherein the one way hashing scheme is intended to conceal the email list entries from an intended recipient (Col 2, starts at line 20; claims 15, 16; hash of email address; mapping id to email address to conceal email address);

transferring the set of one or more hashed email list entries to a master email list server configured to store the set of one or more hashed email list entries (Col 2, starts at line 30; Col 8, starts at line 56; synchronization/transferring of client server email list/contact information);

requesting from the master email list server at least one hashed email list entry from the set of one or more hashed email list entries to create or update a client email list on a client machine (Col 2, starts at line 30; transferring server email list to client);

causing a client email entry to be hashed using the same one-way hashing scheme to create a hashed client email entry (Col 2, starts at line 30); and

comparing the hashed client email entry to the client email list to determine whether the hashed client email entry appears on the client email list (Col 2, starts at line 15).

Although Morkel discloses the email list, it fails to disclose use of a do-not-email list, or a master do-not-email list.

However, Ben Livingston discloses a maser do not email list (Par 3-5; do not email; mailing list in domain registrant). Furthermore, Russell discloses use of a do-not-email list, or a master do-not-email list (Col 3, starts at line 33; do not contact list; subscriber database).

Russell, Ben Livingston and Morkel are analogous art because they are from the same field of endeavor of secure communication. At the time of the invention it would have been obvious to a person of ordinary skill in art to combine the teaching of Ben Livingston or Russell with Morkel to design a method further include a do not email list in order to provide an efficient anti-spam mechanism.

***Regarding claim 30***, it is rejected applying as above rejecting claim 29, furthermore, Morkel discloses the method wherein the hashed client email entry is a hashed value of an email address stored on the client machine, the client machine performs the causing of the client email entry to be hashed, the client machine performs the requesting from the email list server, and the client machine performs the comparing the hashed client email entry to the client email list (Col 2, starts at line 20; claims 15, 16; hash of email address; mapping id to email address to conceal email address).

Although Morkel discloses the email list, it fails to disclose use of a do-not-email list, or a master do-not-email list.

However, Ben Livingston discloses a maser do not email list (Par 3-5; do not email list; mailing list in domain registrant). Furthermore, Russell discloses wherein the client email entry is a hashed value of an email address stored on the client machine, the client machine performs the requesting from the master email list server, and the client machine performs the comparing the client email entry to the client email list (Col 3, starts at line 33; do not contact list at client; comparing with subscriber database; SMS).

***Regarding claim 31***, it is rejected applying as above rejecting claim 30, furthermore, Morkel discloses the method wherein the hashed client email entry is a hashed value of an email address stored on the client machine and the client machine performs the causing of the client email entry to be hashed (Col 2, starts at line 20; claims 15, 16).

***Regarding claim 32***, it is rejected applying as above rejecting claim 31, furthermore, Morkel discloses configuring a master email list database to be in communication with the master email list server, the master email list database configured to store the set of one or more hashed email list entries for the email list server (Col 2, starts at line 20; claims 15, 16).

Although Morkel discloses the email list, it fails to disclose use of a do-not-email list, or a master do-not-email list.

However, Ben Livingston discloses a maser do not email list (Par 3-5; do not email list; mailing list in domain registrant). Furthermore, Russell discloses configuring a master do-not-email

list database to be in communication with the master do-not-email list server, the master do-not-email list database configured to store the set of one or more do-not-email list entries for the master do-not-email list server (Col 3, starts at line 33).

*Regarding claims 33-35*, they recite the limitations of claims 29-32, therefore, they are rejected applying as above rejecting claims 29-32.

*Regarding claim 36*, Ben Livingston discloses the method as in claim 35 wherein the email marketer uses the client do-not-email list application to periodically check bulk email lists maintaining by the email marketer to have email addresses associated with the set of one or more do-not-email list entries be kept free of spam (Par 3-5; do not email list; spammer must contact registrant). Furthermore, Russell discloses the email marketer uses the client do-not-email list application to periodically check bulk email lists maintaining by the email marketer to have email addresses associated with the set of one or more do-not-email list entries be kept free of spam (Col 4, starts at line 30).

*Regarding claim 67 and 71*, they are rejected applying as above rejecting claim 29, furthermore, Morkel discloses a computer implemented method to identify email addresses registered on a do not contact list that are in a client's list without revealing the email addresses on the contact list or the client's list Comprising:

the client encrypting at least certain of entries on the client's list to create a plurality of encrypted entries, where each entry includes at least an email address (Col 2, starts at line 47;

contact information; matching hash; Col 4, starts at line 60; encrypted id/email address/  
data);

the client transmitting over a network said plurality of encrypted entries from the client's list to a service for comparison to encrypted entries of the contact list, wherein the encrypted entries of the contact list were formed by encrypting information, including at least an email address, a matching of an encrypted entry from said plurality of encrypted entries from the client's list to an entry of the contact list represents that the underlying email address needs to be identified (Col 2, starts at line 47; Col 4, starts at line 60; matching; encrypted id/email address/data); and

the client receiving results of the comparison (Col 2, starts at line 47; Col 4, starts at line 60; matching).

Although Morkel discloses the email list, it fails to disclose use of a do-not-email list, or a master do-not-email list.

However, Ben Livingston discloses a maser do not email list (Par 3-5; do not email; mailing list in domain registrant). Furthermore, Russell discloses use of a do-not-email list, or a master do-not-email list (Col 3, starts at line 33; do not contact list; subscriber database).

***Regarding claims 68-70, 72-78***, they recite the limitations of claims 29-36 and 67, therefore, they are rejected applying as above rejecting claims 29-36 and 67.

***Regarding Claim 79***, it recites the limitations of claims 29 and 67, therefore, it is rejected applying as above rejecting claims 29 and 67.



6. Claims 80 - 82 are rejected under 35 USC 103 (a) as being unpatentable over Morkel (US 7007068 B2) in view of Ben Livingston ( Possible modifications to Washington, anti-spam law, Internet Newsgroup, January 31, 2002) further in view of Russell (US 7099444B1) further in view of Lu (US 7174453 B2).

*Regarding claim 80*, it is rejected applying as above rejecting claim 79, furthermore, Morkel fails to disclose wherein when the encrypted entry that matches one of the encrypted entries of the master do-not-contact list of belongs to the minor is automatically removed from the client's list.

However, Ben Livingston discloses a maser do not email list (Par 3-5; do not email; mailing list in domain registrant).

Furthermore, Lu teaches when the encrypted entry that matches one of the encrypted entries of the contact list of belongs to the minor is automatically removed from the client's list ( Col 3, starts at line 5; Col 4, starts at line 12; claims 12, 36; block/delete intended recipient/child senders; forwarding/directing to supervisory/parent or guardian recipient).

Lu and Morkel are analogous art because they are from the same field of endeavor of secure communication. At the time of the invention it would have been obvious to a person of ordinary skill in art to combine the teaching of Lu with modified Russell- Ben Livingston - Morkel method to include when the encrypted entry that matches one of the encrypted entries of the contact list of belongs to the minor is automatically removed from the client's list in order to provide internet security for the minors.

*Regarding claim 81*, it is rejected applying as above rejecting claim 80, furthermore, Lu discloses associating the email address that belongs to the minor with a parent's address ( Col 3, starts at line 5; claims 12, 36).

*Regarding claim 82*, it is rejected applying as above rejecting claim 80, furthermore, Morkel discloses the encrypted entry that belongs to the client's list (Col 4, starts at line 60).

Morkel fails to disclose causing a notification to be sent to the parent's address to notify the parent when there is a request to remove the contact information associating with the entry that belongs to the minor from the client's list.

However, Lu discloses causing a notification to be sent to the parent's address to notify the parent when there is a request to remove the contact information associating with the entry that belongs to the minor from the client's list (Col 3, starts at line 5; claims 1,12- 13, 3 6; notification to supervisory/parent; intended/child).

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

Application/Control Number:  
.10/671,119  
Art Unit: 2136

Page 10

calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shanto M Z Abedin whose telephone number is 571-272-3551. The examiner can normally be reached on M-F from 9:00 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Moazzami Nasser, can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shanto M Z Abedin

Examiner, A.U. 2136

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1/30/08